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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,107	03/30/2004	Richard M. Peterson	SMD-58-CON	5544
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EXAMINER				
LAZORCIC, JASON L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,107

Applicant(s)

PETERSON ET AL.

Examiner

JASON L. LAZORCIK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/30/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-65, 68-108 and 110-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-65, 68-108 and 110-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 41-65, 68-108, and 110-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (US 5,878,753) in view of Hampl (US 4,739,755) and Hampl (US 6,298,860 B1).

With respect to independent **claims 41, 70, 83, and 113**, Peterson teaches a paper wrapper for a cigarette and the cigarette comprising said wrapper and tobacco column as depicted in the instant reference Figures 1 and 2. Figure 2 teaches cigarette paper web presenting a plurality of "discrete circumferential bands" [**Claims 42, 84**] coated with a film forming composition wherein consecutive bands are spaced apart by untreated regions of paper web. The reference clearly teaches that the treated regions have "a preferred permeability less than 6 ml/min.cm² (Coresta), and generally within a range of 2-6 ml/min/cm²." (Column 5, lines 57-62) [**Claim 68, 95, 111**]

It is the Examiners understanding that both the Coresta (CU) and BMI or "Burn mode index" represent alternate but effectively equivalent measures of porosity and in the instant case specifically describe the porosity of the treated region or bands. To this end, although Peterson discloses a Coresta value for the bands which reads upon the claimed range, the reference fails to disclose the treated band porosity as measured by the BMI value.

The patent to Hampl et. al. (US 4,739,775) provides insight into the BMI value and its relation to the CU. The Hampl reference relates the methods of acquiring a BMI value in addition to presenting an exemplary comparison between the Coresta value of a wrapper (30 CU) and its equivalent porosity as measured by BMI (14 cm⁻¹) (see Table 1). By the Hampl reference, it is the Examiners understanding that the CU and

BMI are related by an approximate 2:1 ratio (e.g. 30 CU:14 BMI). Therefore absent compelling evidence to the contrary, Peterson is understood to teach a treated band presenting a BMI value of approximately 3 cm^{-1} or less (e.g. half the CU value of less than 6 CU) [**Claim 69, 81, 82, 112**].

With respect the particular details of band width and spacing as required by **Claims 70 and 113**, the Peterson reference teaches that "Applicants have determined that, for the cigarettes tested, a minimum band width of 4mm is desired" (Column 6, Lines 3-4) [**claim 43, 85**] and that "In the cigarettes tested, applicants have found that a band spacing of between 5 and 10mm is appropriate" (Column 6, Lines 18-19) [**Claim 44, 45, 86, 87**].

Peterson further sets forth both band spacing and band width as clear result effective variables subject to empirical optimization. Specifically, Peterson teaches that the "width and spacing of bands are dependent on a number of variables, such as the initial permeability of wrapper 14, density of tobacco column 12, etc". The reference continues by teaching that the bands preferably have a width sufficient to limit the oxygen provided to the burning coal. The reference further asserts that the band spacing should not be so large as to promote burning trough the bands, but not so small as to self-extinguish the cigarette in a free-burn state. Therefore, the band width and band spacing are held as result effective variables of the paper wrapper which one of ordinary skill in the art would be able to optimize through routine experimentation.

The instant reference further discloses that "Applicants have found that a non-aqueous solution of a solvent soluble cellulosic polymer with a particulate inorganic non-

reactive filler suspended in solution works particularly well" (Column 6, Lines 25-28) [Claim 52, 57, 58, 63, 64, 73, 94, 100, 101, 106, 107]. The reference continues by teaching that particularly well-suited fillers include titanium oxide or a "metal oxide" [Claim 65, 72, 74, 108] (Column 7, Line 5) and that ethyl cellulose acts as a preferred binder for the filler particles (Column 6, Lines 54-56) [Claim 75]. While the above coating composition sets forth a preferred embodiment, Peterson teaches that aqueous solutions [Claim 56, 99] which a variety of common film forming components include alginate, polyvinyl alcohol [Claim 48, Claim 50, 90, 92]. Although not expressly disclosed in the instant reference, one of ordinary skill in the art would recognize both polyvinyl acetate and starch as potential substitutes for the film forming component in the film forming composition [Claim 49, claim 51, 71, 91, 93].

IN discussing the mode of depositing the bands, Peterson discloses that the bands are deposited using a commercial gravure press in a 3 pass process [Claim 46, 47, 79, 80, 88, 89]. Said deposition produces a "ramp pattern" increasing gradually from 0% to 100% over the three printing passes Column 11, Lines 26-57). The disclosed process is understood to vary the amount of film forming composition applied to the paper web by at least 1% between at least two of the layers [Claim 53, 54, 96, 97].

Now, Peterson fails to explicitly teach the application of an alkali metal citrate to the paper web to act as a "burn control additive", however such an addition would have been readily obvious to one of ordinary skill in the art at the time of the invention. Again

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looking to the analogous teachings of Hampl (US 4,739,775), it is disclosed that "While the base cigarette paper may be conventional, it may contain small amounts of an ash conditioner, such as potassium citrate. However the amount of the ash conditioner must be below the level which causes the wrappers to support combustion of a cigarette in spite of the bands. (Column 4, Lines 52-58). It would have therefore been obvious to one of ordinary skill in the art at the time of the invention to modify the Peterson invention to include a burn control additive such as an alkali citrate [**Claims 60, 61, 62, 103, 104, 105**]. This would have been an obvious modification to one of ordinary skill seeking to promote ash formation in a cigarette article.

Additionally, while Peterson teaches the use of a particular commercially available brand of paper (e.g. Kimberly-Clark Corporation KC Grade 603 paper) with a porosity of approximately 35 CU, the reference fails to explicitly teach the use of a paper web having a permeability of greater than about 60 CU as required by independent Claims 41, 70, 83, and 113. That said, Peterson does teach that "Wrapper (14) may include any manner of commercially available cigarette wrapper,...It should be understood that any other manner of paper web may be used in this regard." (Column 5, Lines 23-27).

Hampl (US 6,298,860 B1) teaches the use of a paper for constructing smoking articles having a basis weight from 18 gsm to 60 gsm [**Claims 59, 102**] and also having "a permeability of from about 5 Coresta units to about 80 Coresta units" (Column 2, Lines 46-51). Since the use of a cigarette paper having a porosity of about 80 Coresta

units is known in the art of cigarette manufacturing and Peterson teaches that any manner of commercially available cigarette paper can be used in the disclosed invention, the use of a paper having a permeability of "greater than about 60 Coresta" or "greater than about 80 Coresta units" would have been obvious modification to the Peterson process at the time of the invention [**Claims 55, 76, 77, 78, 98**].

Response to Arguments

Applicant's arguments filed October 30, 2007 have been fully considered but they are not persuasive.

Applicant argues that "none of the above references either alone or in combination teach a paper wrapper or a smoking article containing a paper wrapper wherein the paper wrapper has a permeability of greater than about 60 Coresta and has a treated discrete areas having a permeability of less than about 25 Coresta and/or includes treated discrete areas having a BMI of less than about 5 cm⁻¹".

With respect to these allegations, Applicant first acknowledges that the Peterson reference teaches that "any manner of commercially available cigarette wrapper" may be employed for use as the wrapper in the prior art wrapper product. Applicant further acknowledges, in view of the Hampl '860 reference, that paper wrapper papers having a porosity from about 5 CU to about 80 CU were known and available for use in the cigarette arts. The Examiner here notes that although the Peterson reference teaches a preferred embodiment comprising a wrapper with a permeability of 35 Coresta Units,

said reference in no manner explicitly nor implicitly excludes the use of higher porosity papers.

Finally, Applicant admitted in the reply filed July 11, 2007 that the wrapping paper utilized in constructing a smoking article is "primarily responsible for controlling various properties of the smoking article". In this passage, Applicant continues by stating that "the wrapper...primarily controls the puff count of the smoking article, the tar delivery, the carbon monoxide delivery, and the amount of mainstream smoke and sidestream smoke that is generated by the smoking article." In accordance with the foregoing statements on the record, it is understood that Applicant has acknowledged that the wrapper porosity contributes in an established and predictable manner to at least the noted properties of a cigarette (page 10, lines 7-17).

In summary, Peterson teaches that any commercially available cigarette paper may be used in the fabrication of the disclosed invention, Hampl '860 discloses papers having porosity up to about 80 Coresta units were known for use in cigarettes, and Applicant admits that the porosity of cigarette wrappers contributes in a known and predictable manner to the burn characteristics of the final product. It follows that one of ordinary skill in the art would have found it as a merely trivial extension over the prior art teachings to try the Hampl wrappers with porosity up to "about 80 CU" in the burn controlled cigarette structure disclosed by Peterson as a means to optimize the burn characteristics of the resultant wrapper.

To the extent that Applicant argues that the use of a higher porosity wrapping

papers (e.g. about 60 CU or about 80CU) as taught by Hampl in the wrapper structure as taught by Peterson can not result in the other defined wrapper properties, Applicant is advised that the wrapper resulting from the combined prior art references has been shown to be structurally indistinguishable from the claimed wrapper. Further, Applicant has provided no evidence on the record to support the instant allegation, namely that the wrapper resulting from the combined prior art wrapper is necessarily excluded from exhibiting the other claimed wrapper properties. Since Applicant has provided no conclusive evidence in support of the instant allegations, it follows that said allegations are held to be mere conjecture and attorney argument.

The Official policy regarding Attorney argument is clearly outlined in MPEP §2145 [R-3];

"Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

Conclusion

This is a continuation of applicant's earlier Application No. 10/813,107. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON L. LAZORCIK whose telephone number is (571)272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL

/Eric Hug/
Primary Examiner